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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,535	04/15/2004	Jay S. Walker	03-034	8238
22927 7590 02/17/2009 WALKER DIGITAL MANAGEMENT, LLC 2 HIGH RIDGE PARK STAMFORD, CT 06905				
EXAMINER				
MOSSER, ROBERT E				
ART UNIT		PAPER NUMBER		
3714				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/825,535

Applicant(s)

WALKER ET AL.

Examiner

ROBERT MOSSER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 12th, 2009 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-34 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for separate embodiments of providing questions regarding a prize player is competing for and an embodiment wherein the question presented to the player is unrelated to the prize, this does not reasonably provide enablement for the concurrent presentation of both embodiments. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The separate presentation of question embodiments does not clearly illustrate the manner in which both embodiments would function in combination as presently claimed thereby raising the issue of scope of enablement.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chu (US 2004/0148221) in view of Philyaw (US 6,631,404) in further view of Auxier (US 5,009,429) in yet further view of Von Kohorn (5,697,844).

(i) Combination of references and features thereof reflective of claimed elements

Chu teaches the general networked gaming and prize system as correlated below and including the limiting of advertisement presentations to a user based on user

criteria. Chu is arguably silent regarding the inclusion of targeted advertisement, this feature however is taught by the related teachings of Philyaw wherein Philyaw provides for the restriction of advertisement by geographical location of the user according to the desires of the advertisement sponsor (*Philyaw* Col 20:23-29; 23:30-42). It would have been obvious to one of ordinary skill in the art at the time of claimed invention to have incorporated the features of Philyaw into the invention of Chu because such a combination would represent a mere combination of known elements through a conventional manner to produce an expected result of directing advertisement to intended geographical markets.

The combination of Chu & Philyaw is silent regarding allowing participant to choose the prizes they will compete for prior to the initiation of game play, however this feature is taught by Auxier (*Auxier* Col 5:38-48). It would have been obvious to one of ordinary skill in the art at the time of invention to enable the player to select the winner's prize prior to game play in order to encourage player interest and effort in game play that would otherwise be absent if the player was uninterested in the prizes associated with the game.

The combination of Chu, Philyaw & Auxier teaches the presentation of a game and prizes including downloadable gift certificates and coupons however, the combination is silent regarding allowing a user to print the coupons/certificates and the use of validation codes to authenticate these certificates. These features however are common to enabling the redemption of electronic certificates in brick and mortar establishments. In a device directed to enabling players to play online games and

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rewarding successful players Von Kohorn teaches the printing of coupons/certificates including validation means to provide players with prizes in a hard copy version(*Von Kohorn* Col 5:3-17, 86:20-30). It would have been obvious to one of ordinary skill in the art at the time of invention to have implemented the teachings of Von Kohorn into the combination of Chu, Philyaw, & Auxier in order to enable redemption of coupons at dining establishments or other venues where online redemption would be impractical.

Additionally the combination of Chu, Philyaw & Auxier does not explicitly teach the presentation of trivia questions related to an award and questions specifically unrelated to an award. The prior art of Von Kohorn however teaches the presentation of questions related to a trivia prize and the presentation of questions unrelated to a specific prize (*Von Kohorn* Col 47:12-21, 52:66-53:22). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated both the presentation of questions related to a trivia prize and the presentation of questions unrelated to a specific prize as taught by Von Kohorn into the combination of Chu, Philyaw, & Auxier in order to the player to compete for their desired prize while answering a set of questions related to the prize and additional products offered by the sponsor but not available as a prize..

(ii) Direct correlation of claim elements to the prior art

Claims **1-5**, **15-16**, and **23-33**: The combination of Chu/Philyaw/Auxier teaches and system and method for providing a local edition of an online game including:

a game system (*Chu* Figure 6, Elm 155); and

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a game server in communication with the game device (*Chu* Figure 6, Para 0009); and further including:

a processor (*Chu* Para 12 & 86);;

a first storage device in communication with the processor for storing program code wherein when the program code is executed on the processor (*Chu* Para 85) for:

receiving of a geographic location from the gaming device (*Chu* Fig 10);

determining geographic location associated with a prize/product sponsor/merchant (*Philyaw* Col 23:33-42);

producing game content based on the geographical location of the device and sponsor/merchant (*Philyaw* Col 23:33-42, 24:55-25:10);

providing the game content to the game device (*Chu* Para 10);

determining a prize/product to offer the player based on their geographic location(*Philyaw* Col 23:33-42, 24:55-25:10), game performance (*Chu* Para 43-44), and the geographic location of the prize/product sponsor/merchant (*Philyaw* Col 23:33-42, 24:55-25:10);

receiving a selection from the player of a prize/product offer and converting the offer into an entitlement for the respective prize/product/offer (*Chu* Para 40, 43-44);

a second storage device storing data identifying a plurality of prize/product sponsor/merchants associated with a respective geographic location and associated with at least one respective prize/product (*Chu* Para 72); and

providing both questions directed to a prize which the player may win and questions that are not attached to a prize which the player may win (*Von Kohorn* Col 47:12-21, 52:66-53:22).

Claim 6-7: The combination of Chu, Philyaw, Auxier, & Von Kohorn additionally teaches adjusting the measure of game performance based on the play of the game (*Chu* Para 40, 43-44, 47).

Claims 8-11, and 20: The combination of Chu, Philyaw, Auxier, & Von Kohorn additionally teaches displaying the user performance in terms of points/credits that can be redeemed for merchandise (*Chu* Para 40, 47).

Claims 12-14: The combination of Chu, Philyaw, Auxier, & Von Kohorn teaches the inclusion of player coupons awarded in response to game play actions, these coupons are understood to inherently reduce the purchase price of an item from a target or retail price based on the player's game activities as set forth above.

Claims 17-19, and 34: The combination of Chu, Philyaw, Auxier, & Von Kohorn additionally teaches presenting the player information regarding a plurality of products either from within the game, in a manner separate from the game (*Chu* Para 40, 41, 48).

Claims 21-22: The combination of Chu, Philyaw, Auxier, & Von Kohorn additionally teaches providing the user a manner to provide payment in exchanges for good (*Chu* Para 46).

Response to Arguments

Applicant's arguments filed January 12th, 2009 have been fully considered but they are not persuasive. Specifically the applicant argues the newly presented claim features of independent claims 1,4,5,25, 33 as providing both an association and separation between the presented trivia questions and the prize which the player is competing for. As previously presented the combination of Chu, Philyaw, Auxier, & Von Kohorn provides for the player selection of a prize while the rejection as amended above references teachings in the previously applied reference of Von Kohorn for the relevant discussion of presenting trivia questions related to a prize or in absence of a prize. The introduction of these elements into the correlation of the claimed invention under the prior art combination of Chu, Philyaw, Auxier, & Von Kohorn is presented as providing newly amended features.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry. Suhol/
Supervisory Patent Examiner, Art
Unit 3714

/R. M./
Examiner, Art Unit 3714